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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,239	05/09/2001	Jay S. Walker	01-014	4078

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EXAMINER

BROCKETTI, JULIE K

ART UNIT PAPER NUMBER

3713

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/852,239

Applicant(s)

WALKER ET AL.

Examiner

Julie K Brockett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06112002\_08052002
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Priority***

Applicant's claim for domestic priority under 35 U.S.C. 120 is acknowledged. However, the parent applications upon which priority is claimed fail to provide adequate support under 35 U.S.C. 112 for claims 1-14 of this application. The parent applications do not recite determining a game result based on the player input parameter and the game of skill, wherein the game of skill inhibits performance of an automated game playing device by determining the game result in part based on a value that is not transmitted to the remote player device. Furthermore, the parent applications do not recite a physics simulation. Therefore, this application's priority date is the date of filing which is May 9, 2001.

***Information Disclosure Statement***

The information disclosure statements filed June 11, 2002 and August 5, 2002 fail to comply with 37 CFR 1.98, which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Numerous foreign abstracts were submitted for consideration. They have not been considered because a copy of the entire

foreign patent was not submitted as required and in some cases where the entire foreign patent was submitted an English language explanation of its relevance was not submitted so those foreign patents have also not been considered. Also "Gambling on a PC near you" from PC Magazine May 16, 1995 was not considered because only the abstract of the article was submitted not the article itself.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are a to "a computer-implemented method" which is a program per se which is held to be non-statutory, *Warmerdam 33F.3d at 1361, 31 USPQ2d at 1760*. Only when functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since the use of technology permits the function of the descriptive material to be realized. See MPEP 2106.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Zucker et al., U.S. Patent No. 6,468,155 B1.** Zucker discloses a method of facilitating game play at a game controller comprising: receiving from a player a fee to play a game of skill; receiving a player input parameter from a remote player device via a communication network. A game result is determined based on the player input parameter and the game of skill. The game of skill inhibits performance of an automated game playing device by determining the game result in part based on a value that is not transmitted to the remote player device. A prize is provided to the player based on the game result (See Zucker col. 22 lines 41-50; col. 20 lines 34-42) [claims 1, 10, 13, 14]. The remote player device comprises at least one of (i) a personal computer, (ii) a portable computing device, (iii) a personal digital assistant, (iv) a telephone, (v) a wireless telephone, (vi) a game terminal, (vii) an interactive television device, and (viii) a kiosk (See Zucker col. 22 lines 30-35) [claim 2]. The communication network comprises at least one of: (i) the Internet, (ii) a

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public network, (iii) a public switched telephone network, (iv) a proprietary network, (v) a cable television network, (vi) a wireless network, and (vii) a local area network (See Zucker col. 22 lines 36-40) [claim 3]. The fee received from the player is via a payment identifier (See Zucker col. 22 lines 51-52) [claim 4]. The payment identifier is associated with a least one of: (i) a credit card account, (ii) a debit card account, (iii) a bank account, and (iv) a digital payment protocol (See Zucker col. 22 lines 53-56) [claim 5]. The prize comprises payment of at least one of (i) a monetary amount, and (ii) an alternate currency (See Zucker col. 22 lines 57-59) [claim 6]. The game of skill comprises a game associated with a physics simulation. The value comprises a randomly generated value associated with the physics simulation (See Zucker col. 20 lines 29-42) [claims 7, 14]. The player input parameter and the randomly generated value are input into the physics simulation to determine the game result (See Zucker col. 22 lines 34-46) [claim 8]. The physics simulation comprises at least one of a golf simulation, a golf putting simulation, an archery simulation, a moving water simulation, a racing simulation, a fishing simulation, a baseball simulation, a basketball simulation, a football simulation, a soccer simulation, a hockey simulation, a bowling simulation, a billiards simulation, a throwing simulation, a ring-toss simulation, a shooting simulation and a space simulation (See Zucker col. 14 lines 24-37) [claim 9]. The game controller comprises a processor and a storage device in communication with the processor and stores instructions

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adapted to be executed by the processor (See Zucker Fig 2) [claim 10]. The storage device further stores at least one of: (i) a player database, (ii) a game play database, and (iii) a game database (See Zucker col. 16 lines 27-30) [claim 11]. A communication device is coupled to the processor and adapted to communicate with at least one of (i) a player device, and (ii) a payment device (See Zucker col. 15 lines 35-38) [claim 12]. A medium stores the instructions adapted to be executed by a processor to perform the method of facilitating game play at a game controller (See Zucker col. 15 lines 40-45) [claim 13].

The Examiner has rejected the claims also under Koza and Moritome in case the Zucker reference is somehow overcome.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koza, U.S. Patent No. 6,767,284 B1 in view of Moritome et al., U.S. Patent No. 6,589,117 B1.** Koza discloses a method of facilitating game play at a game controller comprising: receiving from a player a fee to play a game of skill; receiving a player input parameter from a remote

player device via a communication network. A game result is determined based on the player input parameter and the game of skill. A prize is provided to the player based on the game result (See Koza col. 6 lines 45-51; col. 10 lines 7-67; col. 12 lines 50-65) [claims 1, 10, 13, 14]. The remote player device comprises a personal computer (See Koza col. 6 lines 20-25) [claim 2]. The communication network comprises the Internet (See Koza col. 6 lines 48-51) [claim 3]. The fee received from the player is via a payment identifier (See Koza col. 8 lines 44-65) [claim 4]. The payment identifier is associated with a least a credit card account (See Koza col. 8 lines 44-65) [claim 5]. The prize comprises payment of a monetary amount (See Koza col. 13 lines 13-39) [claim 6]. The game controller comprises a processor and a storage device in communication with the processor and stores instructions adapted to be executed by the processor (See Koza col. 30 lines 29-37) [claim 10]. The storage device further stores at least one of: (i) a player database, (ii) a game play database, and (iii) a game database (See Koza col. 30 lines 38-46) [claim 11]. A communication device is coupled to the processor and adapted to communicate with at least one of (i) a player device, and (ii) a payment device (See Koza col. 30 lines 10-25) [claim 12]. A medium stores the instructions adapted to be executed by a processor to perform the method of facilitating game play at a game controller (See Koza col. 6 lines 25-32) [claim 13]. Koza lacks in disclosing that the game of skill inhibits performance of an automated game playing device by



determining the game result in part based on a value that is not transmitted to the remote player device.

Moritome et al. teaches of a fishing game in which the game of skill inhibits performance of an automated game playing device by determining the game result in part based on a value that is not transmitted to the remote player device (See Moritome col. 12 lines 6-19) [claims 1, 10, 13, 14]. The game of skill comprises a game associated with a physics simulation. The value comprises a randomly generated value associated with the physics simulation (See Moritome col. 12 lines 6-19) [claims 7, 14]. The player input parameter and the randomly generated value are input into the physics simulation to determine the game result (See Moritome col. 12 lines 6-19 [claim 8]. The physics simulation comprises a fishing simulation (See Moritome Fig. 18B)) [claim 9]. For example, in Moritome the player inputs controls into the game using the fishing rod, these inputs are combined with a random value that is generated for the difficulty of fishing a certain area of the lake, and whether or not the player catches the fish, i.e. game result, is based on the random difficulty level and the player's inputs. It would have been obvious to one of ordinary skill in the art at the time the invention was made to play a game of skill such as Moritome as a skill game in the networked environment of Koza. By playing the game on a network, players can play from any location and do not have to go to a certain location to play the game. Consequently, more players can play the game. It is also obvious to implement the randomly

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generated value as in Moritome into the invention of Koza so that players of various difficulty levels can play the game and all will have some random factor thereby leveling the playfield amongst players.

### ***Citation of Relevant Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Kunzle et al., U.S. Patent No. 6,802,772 B1.

--Kunzle discloses using a set of input parameters for a physics simulation game.

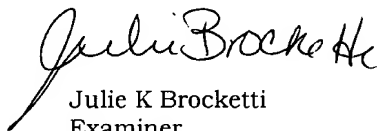
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 703-308-7306. The examiner can normally be reached on M-Th 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 703-308-2064. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Julie K Brockett". The signature is fluid and cursive, with a long, sweeping underline that extends to the left.

Julie K Brockett  
Examiner  
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